UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,867	08/18/2003	Todres Yampel	030/310	3344

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EXAMINER
SETLAK, ANDREW T

ART UNIT	PAPER NUMBER
2166	

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
	10/642,867	YAMPEL, TODRES
Office Action Summary	Examiner	Art Unit	
	Andrew Setlak	2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _18 August 2003_.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-47_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-47_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on _19 April 2004_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _11/12/2003_.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

Drawings

The drawings received on 4/49/2004. These drawings are not acceptable.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the error correction method's features as claimed in claims 14-16, 26-28, 32-35 & 44-47 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to because of inconsistencies between the written

description and the illustrated embodiment, as well as for minor spelling errors. In both

figures 1 and 2 the path from mainframe database (10) to input file (21) is labeled with

"algorith" the examiner believes that this should be changed to "algorithm". Also, from

figure 1 the specification, on pages 4 and 8, refers to the data path from input screens

(22) to new database (20) as performing the transform algorithm N, however figure 1

shows this path as algorithm M. Further, figure 1 also shows said path from mainframe

database (10) to input file (21) as performing "reverse algorith N", yet on page 6 of the

specification this path is said to perform a reverse engineering algorithm of M. Lastly,

on page 5 of the specification it is noted, "the original inputs 11, as well as the arrow

representing the Algorithm M, are shown in dashed lines" yet, in figure 2 this is not the

case. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in

reply to the Office action to avoid abandonment of the application. Any amended

replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The figure or figure

number of an amended drawing should not be labeled as "amended." If a drawing figure

is to be canceled, the appropriate figure must be removed from the replacement sheet,

and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for

consistency. Additional replacement sheets may be necessary to show the renumbering

of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New

Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said first set of input data" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 7-16 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: what said database is to be generated from. The severity of this 112 2nd ¶ rejection is such that the examiner is precluded from performing a proper examination of the claim under 37 CFR 1.104, thus claims 7-16 cannot be evaluated under 35 U.S.C §102 or §103 due to being incomplete.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 36-47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 36-47 appear to be directed to software *per se*.

Data structures not claimed as embodied in computer-storage media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-storage medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer

program and the rest of the computer which permit the computer program's functionality

to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at

1035.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 10 & 17-47 are rejected under 35 U.S.C. 102(b) as being anticipated

by US Patent No. 6,167,405 (henceforth referred to as Rosensteel, Jr. et al.).

Claim 1 is anticipated by Rosensteel, Jr. et al. as follows: **A method of**

generating at least a part of a database from a set of input data, comprising the

steps of: acquiring at least some of said input data from another database, and

generating said database from said first set of input data (C4:L45-47).

Claim 2 is anticipated by Rosensteel, Jr. et al. as in claim 1, **wherein said**

acquired input data comprises at least some data that does not exist in said

another database (C1:L51-54)**, and said step of acquiring further comprises a step**

of generating said non-existing data from data existing in said another database

(C1:L54-57)**.**

Claim 3 is anticipated by Rosensteel, Jr. et al. as in claim 2, **wherein said non-existing data is some of original data from which said another database was generated** (C10:L66-C11:L11).

Claim 4 is anticipated by Rosensteel, Jr. et al. as in claim 3, **wherein said step of generating said non-existing data comprises a reverse-engineering step to acquire said some original data from said existing data in said another database** (C10:L66-C11:L11).

Claim 5 is anticipated by Rosensteel, Jr. et al. as in claim 1, **wherein said input data further comprises data that is not acquired from said another database** (C1:L14-16).

Claim 6 is anticipated by Rosensteel, Jr. et al. as in claim 1, **wherein all of said input data is acquired from said another database** (Rosensteel, Jr. et al.: C6:L44-45, ReTarGet info: page 1, bullet no. 6).

Claims 17-21 & 22-25 are anticipated by Rosensteel, Jr. et al. using the same rationale as applied to claims 1-4.

Claim 26 is anticipated by Rosensteel, Jr. et al. as follows: **A method of generating a database from a set of inputs, comprising steps of: filling said inputs into a sequence of input screens provided by an application for generating said database** (C3:L39-C4:L2); **saving each of said input screens together with said filled inputs** (C3:L39-C4:L2); **and when an error is encountered, generating an error message and retrieving one or more of said saved input screens from which said error was resulted** (C6:L46-51).

Claim 27 is anticipated by Rosensteel, Jr. et al. as in claim 26, **wherein said error is caused by an erroneous input, and said method further comprises highlighting a data field of said erroneous input on said retrieved screens** (Rosensteel, Jr. et al.: C6:L44-45, New Features in ReTarGet Version 5.0: bullet no. 7, users are able to select which classes of errors will be highlighted).

Claim 28 is anticipated by Rosensteel, Jr. et al. as in claim 27, **further comprising steps of correcting said erroneous input in said retrieved screens and resubmitting said corrected input screens to said application** (C8:L15-24).

Claim 29 is anticipated by Rosensteel, Jr. et al. as in claim 26, **further comprising a step of providing an input file which comprises all inputs required by said application** (C2:L65-C3:L4; C3:L23-38).

Claim 30 is anticipated by Rosensteel, Jr. et al. as in claim 29, **wherein said step of filling said input into said input screens is implemented by an automation software application** (C3:L39-45).

Claim 31 is anticipated by Rosensteel, Jr. et al. as in claim 30, **wherein said step of filling comprises a step of, in accordance to input fields provided in said input screens, extracting inputs from said input file and filling said extracted inputs into said input fields** (C3:L66-C4:L2).

Claim 32 is anticipated by Rosensteel, Jr. et al. as in claim 31, **further comprising a step of displaying said retrieved one or more input screens from which said error was resulted** (C6:L51).

Claim 33 is anticipated by Rosensteel, Jr. et al. as in claim 32, **further comprises highlighting one or more data fields of erroneous inputs on said retrieved screens that have caused the error** (Rosensteel, Jr. et al.: C6:L44-45, New Features in ReTarGet Version 5.0: bullet no. 7, users are able to select which classes of errors will be highlighted).

Claim 34 is anticipated by Rosensteel, Jr. et al. as in claim 33, **further comprising steps of correcting said erroneous inputs in said highlighted fields and resubmitting said corrected input screens to said application** (C8:L15-24).

Claim 35 is anticipated by Rosensteel, Jr. et al. as in claim 34, **wherein said step of correcting erroneous inputs on said retrieved screens automatically corrects relevant inputs in said input file** (C3:L39-45).

Claims 36-47 are anticipated by Rosensteel, Jr. et al. using the same rationale as applied to claims 1-6 & 26-35.
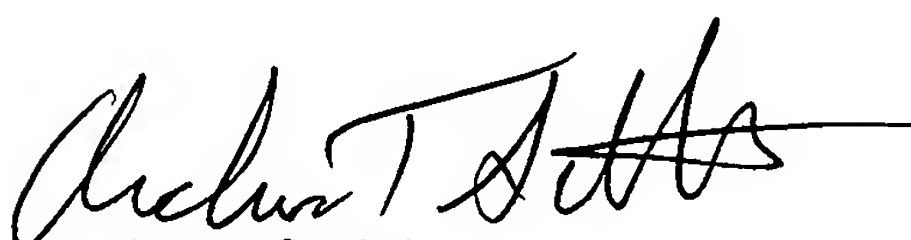
Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Setlak whose telephone number is (571) 272-4060. The examiner can normally be reached on M-F 10:00-6:00.
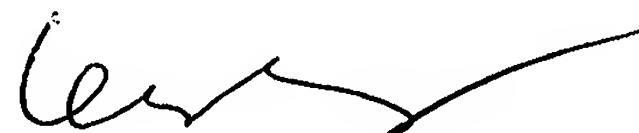
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Andrew Setlak
Patent Examiner
03/24/2006

Leslie Wong
Primary Patent Examiner